

REMARKS

Applicants sincerely appreciate the courtesy of the telephone interview between the Examiner and the undersigned attorney on February 22, 2005. During the interview we discussed currently amended Claim 2 and whether patentable weight would be accorded to the "contingent economic gain" feature as recited in step (c) of currently amended Claim 2. It is applicants' understanding that patentable weight would be so accorded. No agreement was reached as to the allowability of any of the claims.

New Claims 80-94 are presented by this amendment. Support in the original Specification for these new claims and for the amendment of Claim 2 is set forth at page 8, lines 6-9 and page 8, line 19 to page 9, line 9.

The Summary of the Invention portion of the specification is amended to be consistent with currently amended independent Claim 2 and new independent Claim 86.

Claim Rejections 35 USC § 103

The claims presently in the case are patentable over *Uchio* in view of *Kossovsky* by reason of, *inter alia*, the features recited in step (c) of currently amended independent Claims 2 and 69 and in step (b) of new independent Claims 86 and 94.

Step (c) of Claims 2 and 69 requires that contingent economic gain be provided to contributors of ideas for prospectively patentable inventions that are accumulated in a computer database, whom are contractually obligated to transfer property rights to inventions derived at least in part from said accumulated ideas.

Step (b) of Claims 86 and 94 requires that contingent economic gain be provided to contributors of ideas for prospectively patentable inventions that are accumulated in a computer database.

These features are neither described nor suggested by either *Uchio* or *Kossovsky*.

The rejection of Claims 2, 3, 32, 35, 39-48, 67, 69 and 77-79 under 35 USC 103(a) as being unpatentable over *Uchio* in view of *Kossovsky* is respectfully traversed for the same reasons as set forth in the Amendment filed September 16, 2004.

The reasons for rejecting 2, 3, 32, 35, 39-48, 67, 69 and 77-79 under 35 USC 103(a) as being unpatentable over *Uchio* in view of *Kossovsky* that were set forth in the Office Action mailed November 24, 2004 were the same reasons as set forth for rejecting these claims in the prior Office Action mailed June 17, 2004. In the Office Action mailed November 24, 2004, the Examiner also responded to the arguments made by Applicants in the Amendment filed September 16, 2004 in response to the Office Action of June 17,

2004. Notwithstanding the Examiner's response to such arguments, Applicants stand by such arguments and do not agree with the Examiner's assertions that the various combinations of features recited in the rejected claims would have been unpatentable over *Uchio* in view of *Kossovsky*.

In addition, Applicants make the following rebuttal to some of the Examiner's assertions pertaining to the subject matter of Claims 2 and 69, 39, 40 and 43 that were set forth in the Response to Arguments portion of the Office Action mailed November 24, 2004.

Claims 2 and 69

Even if the establishment of some contractual obligations may be inherent incident to use of the information processing apparatus described by *Uchio*, not every type of contractual obligation would have been inherent; and there is no teaching in *Uchio* that suggests systematically establishing the type of contractual obligation recited in these claims, to wit: contractual obligations by the contributors of ideas for prospectively patentable inventions that are accumulated in a computer database to transfer property rights to inventions derived at least in part from the ideas accumulated in the database.

Claim 39

Although paragraph 169 of *Uchio* describes the assignment of ID numbers to response requests, and FIGS. 30 and 33 show display screens bearing document ID numbers, such disclosures by *Uchio* do not suggest the feature of requiring persons to enter into a membership as a prerequisite for viewing a portion of an invention-ideas database, as required by dependent Claim 39. Neither of the disclosed ID numbers is a membership ID number.

Although FIG. 16A of *Kossovsky* shows an information-page display having spaces for entry of a serial number and a registration number for a trademark application, there is no suggestion in *Kossovsky* that such numbers are membership numbers; and there is no disclosure in *Kossovsky* suggesting the feature of requiring persons to enter into a membership as a prerequisite for viewing a portion of an invention-ideas database, as required by dependent Claim 39.

Claim 40

Although paragraph 169 of *Uchio* describes the assignment of ID numbers to response requests, and FIGS. 30 and 33 show display screens bearing document ID numbers, such disclosures by *Uchio* do not suggest the feature of requiring contributors of ideas into an invention-ideas database to enter into a membership as a prerequisite for contributing ideas into said database, as required by dependent Claim 40. Neither of the disclosed ID numbers is a membership ID number.

Although FIG. 16A of *Kossovsky* shows an information-page display having spaces for entry of a serial number and a registration number for a trademark application, there is no suggestion in *Kossovsky* that such numbers are membership numbers; and there is no disclosure in *Kossovsky* suggesting the feature of requiring contributors of ideas into an invention-ideas database to enter into a membership as a prerequisite for contributing ideas into said database, as required by dependent Claim 40.

Claim 43


FIG. 30 and paragraph 89 of *Uchio* do not disclose or suggest the feature of recording the time of receipt of each idea contributed for entry into an invention-ideas database, as required by dependent Claim 43. The disclosure of updating information in the database does not suggest recording the time of such an update.

Conclusion

Reconsideration and allowance are respectfully requested.

Respectfully submitted,

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